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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044697
Party	Defendant Martello, Jeannette
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Attachments	Consolidated Opposition to Petitioner's Motion to Amend Complaint and MSJ.pdf (11 pages)(2033297 bytes) Declaration and Exhibits in Support.pdf (43 pages)(3389913 bytes)

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9
10 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
11 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
12

13 ACM ENTERPRISES, INC.,

14 Petitioner,

15 vs.

16 JEANNETTE MARTELLO, M.D.,

17 Respondent.

) Cancellation No. 92044697

) Reg. No. 2932593

) **CONSOLIDATED OPPOSITION TO**
) **PETITIONER'S MOTION TO AMEND**
) **COMPLAINT AND MOTION FOR**
) **SUMMARY JUDGMENT**

) [Filed concurrently with Declaration of
) Brandon M. Tesser]

18 **1. INTRODUCTION.**

19 Petitioner's Motion should be denied. After proceeding for two years on the theories
20 pled in its original petition for cancellation, at the absolute last possible date, and after discovery
21 has long been closed, Petitioner now seeks summary judgment as to claims which the TTAB has
22 not yet granted leave to assert. But there is no justification for Petitioner's decision to wait until
23 the very last minute to assert three new claims, each of which is premised on facts which it has
24 had actual or constructive knowledge of for at least 18 to 20 months. For instance, Petitioner's
25 counts five and six are premised upon the existence of a Thomson & Thomson search report
26 which Martello produced to Petitioner on January 2006 – some 18 months ago. It's proposed
27 count four is premised on the fact that Martello's original application was unverified – Petitioner
28 was certainly on constructive notice of this fact 20 months ago when it commenced this action.
Indeed, Petitioner attached as an exhibit to its cancellation petition a specimen from Martello's

1 unverified application.

2 There can be no denying that Martello will be substantially prejudiced if leave to amend
3 is granted insofar as she has not been afforded an opportunity to challenge, respond to, or engage
4 in discovery as to these unpleaded claims on which Petitioner is concurrently seeking summary
5 judgment. If the Board is inclined to grant leave to amend, Martello must surely be afforded an
6 opportunity to address these claims before having to defend a motion for summary judgment.
7 Such rights are consistent with due process. But if the Board disagrees, then Martello
8 respectfully requests an opportunity to conduct discovery under Fed. R. Civ. P. 56(f) prior to
9 having to oppose Petitioner's motion for summary judgment.

10 **2. STATEMENT OF RELEVANT FACTS.**

11 Petitioner ACM Enterprises, Inc. initiated this proceeding by filing a Petition for
12 Cancellation on July 1, 2005. (*See* Petitioner's Motion for Summary Judgment and for
13 Amendment of the Pleadings ("Motion") at p. 2.) The Petition sought to cancel Martello's mark
14 for SKIN DEEP (the "Mark") on the grounds that: 1) Martello did not use the Mark in
15 commerce; 2) Martello did not use the mark prior to application or registration; and 3) the Mark
16 was obtained fraudulently insofar as Martello failed to use the Mark in commerce. (Declaration
17 of Brandon M. Tesser ("Tesser Decl.") ¶ 2 and Exh. A thereto.) Attached to its Petition as
18 Exhibits one through nine were copies of various documents including TARR summaries of the
19 history of Martello's several applications for SKIN DEEP in various classes (Exhs. 1, 4, and 8)
20 and copies of the specimens which Martello submitted in support of her applications (Exhs. 5,
21 6,7, and 9). (*Ibid.*) Petitioner's counsel must therefore have reviewed the applications
22 themselves prior to filing the Petition, and was therefore aware (or should have been aware),
23 prior to July 2005 that Martello had inadvertently omitted the required verification from her
24 application for the Mark.

25 In August 2005 Martello timely filed an answer to the Petition containing its admissions,
26 denials, and asserting appropriate affirmative defenses as to the claims alleged in the Petition.
27 (Tesser Decl. ¶ 3 and Exh. B thereto.)

28 In October 2005 Petitioner propounded discovery to Martello, including requests for

1 production of documents. On January 6, 2006 Martello produced 401 pages of responsive
2 documents to Petitioner's counsel. (Tesser Decl. ¶ 4.) The January 6, 2006 document
3 production included a Thomson & Thomson Trademark Search Report for SKIN DEEP dated
4 February 21, 2003 (the "Thompson Report"). The Thompson Report was bates labeled "MAR
5 0084" through "MAR 0389" inclusive. On January 13, 2006 Petitioner's counsel confirmed in
6 writing his receipt of Martello's document production which included the Thompson Report.
7 (*Ibid.* at ¶ 6 and Exh. C thereto.)

8 Martello's deposition was conducted on January 18, 2006. During her deposition,
9 Petitioner's counsel questioned Martello about the Thompson Report. (Tesser Decl. ¶ 7 and Exh.
10 D thereto.) There can be no dispute that Petitioner's counsel was firmly aware of the Thomson
11 Report in January 2006. A year later, in February 2007, Petitioner served requests for admissions
12 to Martello asking her to confirm information contained in the previously produced Thomson
13 Report regarding certain alleged third party prior users of the SKIN DEEP mark.¹ Petitioner's
14 Motion fails to provide any explanation for the one-year delay between its receipt of the
15 Thompson Report and the service of its confirming RFAs, the 18 month delay in seeking leave to
16 amend after receiving the Thomson Report, or the 25 month in delay in seeking leave to amend
17 after filing this action and being on constructive notice of the fact that Martello's '367
18 application was unverified.

19 On August 3, 2007, just one day prior to the commencement of its trial testimony period
20 (and therefore the last day for it to file a motion for summary judgment pursuant to TBMP
21 §528.02), Petitioner filed a consolidated motion for summary judgment and for amendment of
22 the pleadings to add three new fraud claims (the "Motion"). The proposed claims relate to two
23 issues: 1) Martello's apparent (inadvertent) failure to submit a verification in connection with her

24
25 ¹/ Petitioner contends that Martello's admission in February 2006 that the Thompson
26 Report contains information regarding prior users of SKIN DEEP also constitutes an admission
27 that she was aware of these third party users at the time she submitted her application for the
28 Mark in March 2004. But this is pure supposition and conjecture by Petitioner, and not
supported by any evidence whatsoever.

1 application for the Mark certifying that she was not aware of any prior users; and 2) if Martello
2 had signed and submitted the requisite verification this would have constituted fraud because the
3 verification would have been false insofar as Martello should have been aware of third party
4 prior users of the SKIN DEEP mark as a result of her receipt of the Thomson Report prior to
5 submitting her application. Petitioner's Motion comes over two years (25 months) after it was
6 aware, or should have been aware, that Martello's application lacked the requisite verification,
7 and one and a half years (18 months) after Petitioner received the Thomson Report.

8 **3. PETITIONER'S SIGNIFICANT AND UNREASONABLE DELAY IN**
9 **SEEKING LEAVE TO AMEND HAS CAUSED SUBSTANTIAL**
10 **PREJUDICE TO MARTELLO AND THEREFORE PETITIONER'S**
11 **MOTION FOR LEAVE MUST BE DENIED.**

12 While it is true that leave to amend should be liberally granted in the interests of justice,
13 the Board may (and should) deny such leave where, as here, the moving party significantly
14 delayed in seeking leave to amend and where such delay has resulted in prejudice to the adverse
15 party. TBMP §507.02 (a) ("A long and unexplained delay in filing a motion to amend a pleading
16 (when there is no question of newly discovered evidence) may render the amendment
17 untimely."); *Trek Bicycle Corp. v. StuleTrek Ltd.* (TTAB 2001) 64 USPQ2d 1540 (motion to
18 amend opposition denied where it was filed eight months after filing of notice of opposition, with
19 no explanation for the delay, and appeared to be based on facts within opposer's knowledge at
20 the time the opposition was filed).

21 Petitioner has substantially, and without justification, delayed in bringing its motion for
22 leave to amend. Petitioner's proposed amendments relate to facts which it knew, or should have
23 known: 1) at the time it filed its Petition in July 2005 (that the '367 application was not
24 verified); and 2) in January 2006 when Martello produced the Thomson Report (that Martello
25 may have known at the time she filed her application that there were third party prior users of the
26 mark). However, Petitioner has failed to provide any explanation whatsoever for the: 1) 25
27 month delay in seeking leave to amend to assert claims based on Martello's failure to provide a
28 verification; and 2) 18 month delay in seeking leave to amend to assert claims based on

1 Martello's possible knowledge of third party prior users of the mark as disclosed in the Thomson
2 Report. And there can be no excuse whatsoever for Petitioner's undue delay in seeking leave to
3 amend. The facts here are particularly egregious because Petitioner is contemporaneously
4 seeking to have these new claims summarily adjudicated in its favor without affording Martello
5 the opportunity to respond to the new claims (in contravention of her due process rights), or even
6 conduct discovery regarding the new claims.

7 The Board has specifically denied leave to amend in circumstances where the delay was
8 only eight months, far shorter than the delay of 25 months and 18 months presented here. *Trek*
9 *Bicycle Corp. v. StyleTrek Ltd.*, *supra*, 64 USPQ2d at 1541. Even if the Board believes that
10 Petitioner was not aware, or simply overlooked, the fact that Martello's application was not
11 verified, Petitioner cannot dispute that it received the Thomson Report on January 6, 2006
12 because its counsel has admitted receiving it on that date. See Exh. C. And therefore it is
13 undisputed that Petitioner delayed at least 18 months before seeking leave to assert claims based
14 on Martello's alleged knowledge of the third party users mentioned in the Thomson Report.

15 A critical factor is whether the undue delay has resulted in prejudice to the adverse party
16 and also whether there is evidence of bad faith or dilatory tactics. *Marshall Field & Co. v. Mrs.*
17 *Field's Cookies* (TTAB 1990) 17 USPQ2d 1652 ("concept of 'undue delay' is inextricably linked
18 with the concept of prejudice to the non-moving party"); *Martinez v. Newport Beach City* (9th
19 Cir. 1997) 125 F.3d 777, 785. Petitioner's conduct in 1) waiting 25 to 18 months before seeking
20 leave to amend; 2) seeking concurrently to have these as yet unpleaded claims summarily
21 adjudicated against Martello; and 3) bringing the motion after the discovery period has been
22 closed has resulted in substantial prejudice to Martello as more fully set forth below. Moreover,
23 Petitioner's conduct in delaying until the last moment to seek leave appears to have been done
24 consciously in order to gain a strategic advantage in this litigation. There simply is no other
25 explanation for Petitioner's decision to wait so long to seek leave to amend with regard to facts
26 of which it had been aware for 25 to 18 months and then to combine the motion for leave with a
27 motion for summary judgment, all after the discovery period has long been closed. This is
28 precisely the scenario under which leave to amend should justifiably be denied. See, e.g.

1 *American Life & Cas. Ins. Co.* (9th Cir. 1998) 151 F.3d 1132, 1139 (motion for leave denied
2 where brought “on the eve” of the discovery deadline); *Campbell v. Emory Clinic* (11th Cir. 1999)
3 166 F.3d 1157, 1162 (“Prejudice and undue delay are inherent in an amendment asserted after the
4 close of discovery”).

5 4. **IF LEAVE TO AMEND IS GRANTED THE BOARD MUST PERMIT**
6 **MARTELLO TO RESPOND TO THE NEW CLAIMS AND HAVE AN**
7 **OPPORTUNITY TO CONDUCT DISCOVERY THEREON – BEFORE**
8 **SHE IS REQUIRED TO OPPOSE PETITIONER’S MOTION FOR**
9 **SUMMARY JUDGMENT.**

10 Martello contends that Petitioner’s motion for leave to amend should be denied for the
11 reasons set forth above. However, if leave to amend is granted, Martello must be afforded an
12 opportunity to respond to, or challenge, the new claims, and conduct discovery thereon – before
13 having to oppose Petitioner’s motion for summary judgment (technically, a motion for summary
14 adjudication).

15 Pleadings in a cancellation proceeding may be amended in the same manner and to the
16 same extent as in a civil action in a United States district court. 37 CFR 2.115. Petitioner’s
17 amended petition is subject to the same challenges as the original (*i.e.*, motion to dismiss, to
18 strike, for a more definite statement, etc.) *Nelson v. Adams USA, Inc.* (2000) 529 U.S. 460, 466,
19 120 S.Ct. 1579, 1584; TBMP §316. And Martello is entitled, indeed required, to provide a
20 response to the amended pleading. *Nelson v. Adams USA, Inc. supra*, 529 U.S. at 466. This
21 opportunity to respond to an amended pleading is fundamental to a party’s due process rights.
22 *Ibid.*

23 Further, it would be improper for the Board to consider Petitioner’s motion for summary
24 judgment before Martello is afforded an opportunity to respond to the newly asserted claims. For
25 example, Martello may need to assert new affirmative defenses. If denied the opportunity to
26 respond by way of answer, Martello could be gravely prejudiced at trial insofar as she would be
27 precluded from relying upon her unpleaded affirmative defenses. *See* TBMP §311.02 ©
28 (unpleaded affirmative defenses cannot be relied upon).

1 In the same vein, in the event leave to amend is granted, the Board must reopen discovery
2 to allow Martello to take discovery on the new matters. Permitting Martello to take discovery on
3 the matters raised in the amended pleadings is the only way to avoid the manifest prejudice to
4 Martello inherent in granting leave to amend after the discovery period is expired. Pursuant to
5 TBMP §507.02(a) the Board has the discretion to reopen the discovery period in this fashion to
6 allow Martello to engage in discovery regarding the new claims.

7 The Board has discretion to grant leave upon conditions ameliorating any hardship to
8 opposing parties. Conditions typically imposed include: an extension of time within which to
9 respond to the amended pleading; reopening discovery to investigate the new claim or defense;
10 and a continuation of the trial date. *See General Signal Corp. v. MCI Telecommunications*
11 *Corp.* (9th Cir. 1995) 66 F.3d 1500, 1514. All that Martello asks is, if the Board is inclined to
12 grant Petitioner's motion to amend, that these reasonable conditions be imposed in order to
13 ameliorate the extreme hardship to her as a result of Petitioner's substantial delay in seeking such
14 leave.

15 **5. MARTELLO SHOULD NOT BE COMPELLED TO FILE AN**
16 **OPPOSITION TO PETITIONER'S PREMATURE MOTION FOR**
17 **SUMMARY JUDGMENT AS TO ITS UNPLEAD CLAIMS.**

18 It is undisputed that a party may not obtain summary judgment on an issue that has not
19 been pleaded. TBMP §528.07; *S. Industries Inc. v. Lamb-Weston Inc.* (TTAB 1997) 45 USPQ2d
20 1293, 1297; *Commodore Electronics Ltd. v. CBM Kabuskiki Kaisha* (TTAB 1993) 26 USPQ2d
21 1503, 1505. Yet that is precisely what Petitioner is attempting to do here by seeking summary
22 judgment with respect to counts four, five and six of its proposed amended petition. A party that
23 seeks summary judgment on an unpleaded issue generally should first move to amend its
24 pleading to assert the matter. TBMP §528.07(a); *Vaughn Russell Candy Co. and Toymaz Inc. v.*
25 *Cookies in Bloom Inc.* (TTAB 1998) 47 USPQ2d 1635, 1635; and *Commodore Electronics Ltd.*
26 *v. CBM Kabuskiki Kaisha, supra*, at 1505.

27 For purposes of summary judgment, the issues are defined by the pleadings. As it stands
28 now, Petitioner's new claims are unplead – and therefore not the proper basis of a motion for

1 summary judgment. There simply is no reason, and Petitioner has articulated none, why the
2 Board should consider summary judgment against Martello as to unplead claims which Petitioner
3 could have sought leave to amend long, long ago. Indeed it was Petitioner's own delay in
4 waiting until the absolute last day to file its motion for summary judgment which necessitated
5 that it concurrently file a motion for leave to amend. Petitioner's delay cannot justifiably result
6 in extreme prejudice to Martello such that she is denied her most fundamental rights to address
7 these new claims prior to having to defend against a motion for summary judgment premised
8 thereon. To be sure, it is inconceivable that Martello could have her Mark cancelled on the basis
9 of claims which: 1) are unplead; 2) she has not yet had an opportunity to challenge; 3) she has
10 not been afforded her due process right to respond to; 4) she has been denied the opportunity to
11 engage in discovery with respect to. Yet that is precisely what Petitioner is seeking to do.

12 Petitioner's motion for summary judgment is simply premature at this time given that the
13 Board has not granted it leave to amend to add these new theories. Further, Martello should be
14 afforded an opportunity to challenge, respond to, and take discovery with respect to these new
15 claims before being required to oppose Petitioner's motion for summary judgment. There is no
16 prejudice to Petitioner in affording these rights to Martello as a condition to granting Petitioner's
17 motion for leave.

18 **6. MARTELLO CANNOT OPPOSE PETITIONER'S MOTION FOR**
19 **SUMMARY JUDGMENT BECAUSE ADDITIONAL DISCOVERY IS**
20 **REQUIRED PURSUANT TO RULE 56(f).**

21 While Martello contends that Petitioner's motion for summary judgment is premature at
22 this time, in the event the Board disagrees, she nevertheless requires additional discovery in order
23 to file an opposition thereto, and hereby requests an opportunity to do so pursuant to Fed. R. Civ.
24 P. 56(f). Petitioner's counsel submits concurrently herewith the requisite declaration² under Fed.
25 R. Civ. P. 56(f) describing: 1) the nature of the discovery sought; 2) the facts sought to be
26

27 ^{2/} In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37
28 CFR §2.20.

1 obtained *via* the contemplated discovery; 3) that there is a likelihood that these facts will create a
2 triable issue of material fact; and 4) the reasons why such evidence cannot be provided at the
3 present time. (See Tesser Decl. ¶¶ 10- 15.)

4 In sum, Petitioner seeks summary adjudication on its as yet unpleaded Counts Five and
5 Six (misabeled as “Count Five”) on the grounds that there are three specific third party prior
6 users of the SKIN DEEP mark (Skin Deep Michigan, Skin Deep Body Spa and Skin Deep Santa
7 Barbara) whose use of the mark is substantially similar to Martello’s such as to create the
8 likelihood of confusion and that registration of the Mark should be cancelled because of either a)
9 the mere existence of the prior third party users (Count Five) or b) Martello’s alleged knowledge
10 of these third party users and failure to disclose this information to the USPTO constitutes fraud
11 in light of the 15 U.S.C. 1051 verified applicant’s statement which she should have filed, but did
12 not (Count Six).

13 There are numerous deficiencies with Petitioner’s arguments, both legal and factual. But
14 from a factual standpoint, Martello should be able to defeat summary adjudication by showing
15 one or more of the following facts with respect to these alleged third party users: 1) their date of
16 first use does not precede Martello’s first use ; 2) their actual goods and services are not similar
17 to Martello’s goods and services; 3) they have abandoned their use of the mark; and 4) there is no
18 actual confusion with Martello’s use of the Mark. Martello needs to conduct Fed. R. Civ. P.
19 30(b)(6) depositions of these alleged prior third party users in order to obtain the information
20 necessary to defeat Petitioner’s motion for summary judgment.

21 **7. CONCLUSION.**

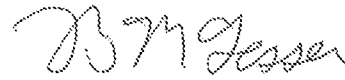
22 There can be no excuse for Petitioner’s substantial delay in seeking leave to amend, and
23 Petitioner’s Motion should be denied on that basis alone. However, to the extent the Board is
24 inclined to grant Petitioner leave to amend, it must be conditioned on affording Martello an
25 opportunity to challenge, respond to, and conduct discovery regarding the new claims. Indeed,
26 due process mandates that she have an opportunity to respond to these new claims. Further,
27 insofar as Petitioner is seeking summary judgment as to unplead claims, its motion is premature
28 at this time and Martello should not be required to oppose it until after she has had time to

1 address the new claims. But in the event the Board deems that a response to the motion for
2 summary judgment is required, Martello must first be given an opportunity to conduct discovery
3 regarding these new claims pursuant to Fed. R. Civ. P. 56(f) as she necessarily does not have
4 evidence in her possession to defend against summary judgment as to claims she has only just re
5 recently been made aware.

6 Dated: September 7, 2007

TESSER & RUTTENBERG

7
8 By:



Brandon M. Tesser
Attorneys for Respondent
Jeannette Martello, M.D.

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CERTIFICATE OF SERVICE

I hereby certify as follows:

I am employed in the COUNTY of LOS ANGELES, STATE of CALIFORNIA. I am over the age of 18 and not a party to the within action; my business address is 12100 Wilshire Boulevard, Suite 220, Los Angeles, California 90025.

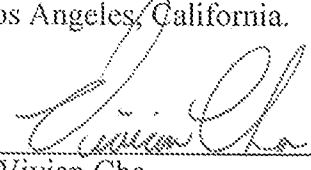
On September 7, 2007, I served the foregoing document(s) described as **CONSOLIDATED OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND AND FOR SUMMARY JUDGMENT** in this action as follows:

- 1) Via electronic mail to: David Hong [david_hong@sbcglobal.net], Counsel for Petitioner herein, and;
- 2) By mail, by placing a true copy thereof enclosed in a sealed envelope addressed as follows:

David Hong, Esq.
Law Office of David Hong
P.O. Box 2111
Santa Clarita, California 91386-2111
Tel/Fax: (866) 824-8680
Attorney for Petitioner ACM Enterprises, Inc.

- ☒ **BY MAIL:** I am readily familiar with my firm's practice for the collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service that same day. I placed true copies of the above-entitled document in envelopes addressed as shown above and sealed and placed them for collection and mailing on the date stated above, following ordinary business practices.
- ☐ **BY PERSONAL SERVICE:** I caused such envelope to be delivered by hand to the offices of the addressee(s) as marked with an ***.
- ☐ **BY FEDERAL EXPRESS:** I caused said envelope(s) to be sent by Federal Express to the addressee(s) on the attached service list.
- ☐ **BY TELECOPIER:** In addition to the above service by mail, hand delivery, or Federal Express, I caused said document(s) to be transmitted by telecopier on September 7, 2007 at approximately _____ a.m./p.m. to the addressee(s) above.
- ☒ (Federal) I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on September 7, 2007, at Los Angeles, California.


Vivian Cha

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7 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
8 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**
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10 ACM ENTERPRISES, INC.,

11 Petitioner,

12 vs.

13 JEANNETTE MARTELLO, M.D.,

14 Respondent.
15

) Cancellation No. 92044697

) Reg. No. 2932593

) **DECLARATION OF BRANDON M.**
) **TESSER AND EXHIBITS IN SUPPORT**
) **OF MARTELLO'S OPPOSITION TO**
) **PETITIONER'S MOTION TO AMEND**
) **COMPLAINT AND MOTION FOR**
) **SUMMARY JUDGMENT**

) [Filed concurrently with Memorandum of
Points and Authorities in Opposition to
Petitioner's Motion]
16
17

18 **DECLARATION OF BRANDON M. TESSER**

19 I, BRANDON M. TESSER, Declare as follows:

20 1. I am an attorney at law, duly licensed and qualified to practice before all courts of the
21 State of California. I am a partner of Tesser & Ruttenberg, counsel of record for Respondent
22 Jeannette Martello, M.D. in the above-captioned action. I make this Declaration in support of
23 Respondent's Opposition to Petitioner's Motion for Summary Judgment and for Amendment of the
24 Pleadings ("Motion"). I am fully competent to make this declaration and I have personal knowledge
25 of each of the following facts, and would and could competently testify thereto if called upon to do
26 so as a witness. To my knowledge, all of the facts stated in this declaration are true and correct.

27 2. On or about July 1, 2005 Petitioner filed its Petition for Cancellation, a true and
28 correct copy of which is attached hereto as Exhibit A and incorporated herein by reference. The

1 Petition asserted three claims only, seeking to cancel Martello's mark for SKIN DEEP (the "Mark")
2 on the grounds that: 1) Martello did not use the Mark in commerce; 2) Martello did not use the mark
3 prior to application or registration; and 3) the Mark was obtained fraudulently insofar as Martello
4 failed to use the Mark in commerce.

5 3. In August 2005 Martello timely filed an answer to the Petition containing its
6 admissions, denials, and asserting appropriate affirmative defenses as to the claims alleged in the
7 Petition. A true and correct copy of Martello's Answer is attached hereto as Exhibit B and
8 incorporated herein by reference.

9 4. In October 2005 Petitioner propounded discovery to Martello, including requests for
10 production of documents. On January 6, 2006 Martello produced to Petitioner's counsel 401 pages
11 of responsive documents.

12 5. The January 6, 2006 document production included a Thomson & Thomson
13 Trademark Search Report for SKIN DEEP dated February 21, 2003 (the "Thompson Report"). The
14 Thompson Report was bates labeled "MAR 0084" through "MAR 0389" inclusive.

15 6. On January 13, 2006 Petitioner's counsel confirmed in writing his receipt of
16 Martello's document production which included the Thompson Report. A true and correct copy of
17 Petitioner's counsel's letter to me dated January 13, 2006 confirming his receipt of various
18 documents, including documents labeled "MAR 0084" through "MAR 0389" (i.e., the Thomson
19 Report), is attached hereto as Exhibit C and incorporated herein by reference.

20 7. Martello's deposition was conducted on January 18, 2006. During her deposition,
21 Martello was examined about the Thompson Report. True and correct copies of relevant excerpts
22 from the January 18, 2006 Martello deposition are attached collectively hereto as Exhibit D.

23 8. In February 2007, Petitioner served requests for admissions to Martello asking her
24 to confirm information contained in the previously produced Thomson Report regarding certain
25 alleged third party prior users of the SKIN DEEP mark.

26 9. At the time Petitioner filed its Motion (August 3, 2007), its testimony period was
27 scheduled to commence on August 4, 2007.

28 ///

Rule 56(f) Issues

10. Petitioner's proposed amended pleading asserts three new claims including Count Five: The registration should not have been granted by the USPTO because Martello had previously conducted a Thomson & Thomson search for the mark SKIN DEEP which allegedly disclosed at least one other third party user of the mark SKIN DEEP; and Count Six (mis-labeled as "Count Five"): Martello's registration was obtained fraudulently in that she failed to disclose to the USPTO the fact that there were prior third party users.

11. Petitioner's motion for summary judgment seeks summary adjudication of these new (and as yet) unpleaded claims. Among other things, Petitioner alleges the existence of three third party prior users of the mark SKIN DEEP who were allegedly using it in connection with the same or similar services as follows:

a. Skin Deep Michigan (Skin Deep Inc., Bloomfield MI 488301-1775) (hereinafter "Skin Deep Michigan"). Petitioner claims Skin Deep Michigan has a first use in commerce date of January 12, 1998 and that it uses the mark in connection with the following goods and services: cosmetic procedures and surgery, non-invasive procedures and skin care products and power peel, hair removal, body wrap, glycolic acid, oxy facial and supra peel.

b. Skin Deep the Body Spa (Huntington Beach, CA 92647-7318)) (hereinafter "Skin Deep Body Spa"). Petitioner claims Skin Deep Body Spa has a first use in commerce date of March 2, 2001 and that it uses the mark in connection with the following goods and services: facials, spa services and skin care products.

c. Skin Deep Santa Barbara (Santa Barbara CA 93105-2625) (hereinafter "Skin Deep Santa Barbara"). Petitioner claims Skin Deep Santa Barbara has a first use in commerce date of July 21, 2001 and that it uses the mark in connection with the following goods and services: beauty products, hair, skin, body, makeup and nails.

12. Martello desires to conduct the following discovery with respect to each of the three alleged prior users: 1) informal interviews to confirm the first use dates, the nature of the goods and services provided, whether the use has been abandoned, whether the use has been continuous, the nature and scope of the use, whether the use is *de minimis*, whether there has been any actual

1 confusion with Martello's use of the mark, etc.; and 2) to take Fed. R. Civ. P. 30(b)(6) depositions
2 of each of the alleged prior users (depending on if the third party users provide any information
3 informally, and if they do, the nature of the information which is received informally). Because
4 these are non-parties, Martello will need to obtain subpoenas from the United States District Court
5 pursuant to Fed. R. Civ. P. 45, and then have the subpoenas served, and possibly need to commence
6 proceedings in the United States District Court to enforcement of the subpoenas

7 13. I reasonably expect that this discovery will reveal that: 1) the first use dates of one
8 or more, perhaps all, of the third party users is incorrect; 2) the nature of the goods and services is
9 incorrect and that therefore there is no likelihood of confusion under 15 U.S.C. 1052 (d); 3) one or
10 more, perhaps all, of the third party users have abandoned their use of the mark; 4) the third party
11 user's use of the mark is *de minimis*; 5) the third party user's use of the mark has not been systematic
12 and continuous; and 6) there is no likelihood of confusion

13 14. I believe that the information outlined above will likely raise a genuine issue of
14 material fact with respect to Petitioner's proposed Counts Five and Six (each of which is premised
15 on the contention that there are prior third party users of the mark in connection with similar goods
16 and services which result in likelihood of confusion) and, therefore, that Petitioner's motion for
17 summary judgment should be denied as premature pursuant to Fed. R. Civ. P. 56(f).

18 15. This information was not sought previously because there was no reason to do so
19 insofar as these issues were not material to this proceeding. The information is material now only
20 because Petitioner has sought leave to add new claims concurrently with its motion for summary
21 judgment. Earlier this year, Petitioner's counsel did mention the possibility that he would be seeking
22 leave to amend to assert fraud, and mentioned the alleged prior third party users – but he did
23 not seek leave to amend until now.

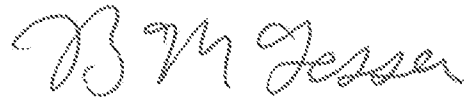
24 16. Petitioner does not believe it is proper to require her to oppose Petitioner's motion
25 for summary judgment as to unpleaded claims, but we are nevertheless submitting this 56(f)
26 declaration in an abundance of caution in the event the Board disagrees.

27 ///

28 ///

1 The undersigned being warned that willful false statements and the like are punishable by
2 fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the
3 like may jeopardize the validity of the application or document or any registration resulting
4 therefrom, declares that all statements made of his/her own knowledge are true; and all statements
5 made on information and belief are believed to be true.

6 Dated: September 7, 2007



BRANDON M. TESSER

EXHIBIT A

ESTTA Tracking number: **ESTTA37541**

Filing date: **07/01/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	ACM Enterprises, Inc.		
Entity	Corporation	Citizenship	CALIFORNIA
Address	1981 New York Drive Altadena, CA 91001 UNITED STATES		

Attorney Information	Michelle Katz 4205 Kester Ave. Sherman Oaks, CA 94103 UNITED STATES michelle@mkatzlaw.com Phone: 8187839729
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Registration Subject to Cancellation

Registration No	2932593	Registration date	03/15/2005
Registrant	Martello, Jeannette 501 Floral Park Terrace South Pasadena, CA 91030 UNITED STATES		
Goods/Services Subject to Cancellation	Class 044. First Use: 20020420, First Use In Commerce: 20040228 Goods/Services: medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services		

Martello adv. ACM - Pleading

Attachments	2005-07-01 Petition to Cancel Skin Deep 2932593 w-attachs.pdf (21 pages)
--------------------	--

Signature	/michellekatz/
Name	Michelle Katz
Date	07/01/2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Reg. No. 2932593)
Reg. Date: March 15, 2005)
Serial No. 76581387)
Filing Date: March 15, 2004)
Mark: SKIN DEEP)
_____)

PETITION TO CANCEL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Madam/Sir:

1. Petitioner, ACM Enterprises, Inc. DBA Skin Deep Laser Med Spa, a California corporation located and doing business at 1981 New York Drive, Altadena, CA 91001, believes that it is or will be damaged by U.S. Registration No. 2932593 for "Skin Deep" for Class 044 and hereby petitions to cancel this Registration.

2. Description of Respondent's Registration: Respondent filed U.S. Trademark Application No. 76581387 on March 15, 2004, for the mark "SKIN DEEP" in class 044 for medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services and claimed first use in commerce on Feb. 28, 2004 and first use anywhere on April 20, 2002. This mark was registered on the Principal Register on March 15, 2005. (See Exhibit 1.)

3. Respondent's Attorney of Record and correspondence information is Brandon Tesser, Esq., Tesser & Ruttenberg, 12100 Wilshire Blvd., Suite 220, Los Angeles, CA 90025;

Respondent's Owner of Record is Jeannette Martello, 501 Floral Park Terrace, South Pasadena, CA 91030.

4. Standing: Petitioner has been and is now, using the mark "SKIN DEEP LASER MED SPA" in connection with the sale of services: providing cosmetic medical treatments namely laser hair removal, wrinkle correction therapies, removal of birthmarks, spider veins, tattoos, hand and facial skin rejuvenation, acne treatments all supervised by licensed medical staff since Sept. 1, 2003 in California and since Jan. 16, 2004 in interstate commerce. This use has been valid and continuous since the date of first use and has not been abandoned.

5. Petitioner has filed for U.S. Trademark Application No. 78569772 on Feb. 17, 2005 for "SKIN DEEP LASER MED SPA" for International Class 044 for the services ("providing cosmetic medical treatments namely laser hair removal, wrinkle correction therapies, removal of birthmarks, spider veins, tattoos, hand and facial skin rejuvenation, acne treatments all supervised by licensed medical staff."). (See Exhibit 2). This mark (SKIN DEEP LASER MED SPA) of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that respondent's registered mark so resembles Petitioner's mark (SKIN DEEP LASER MED SPA) previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

6. Count One: Allegation of Non-Use in Commerce. As grounds of this Petition, it is alleged: Respondent filed the following related trademark applications: In U.S. Serial No. 76581387 for "Skin Deep," the Respondent submitted a specimen of use: a Feb. 18, 2004 Sales Receipt to the U.S. Patent and Trademark Office on March 15, 2004 for medical and health spa services. (See Exhibits 1, 3).

7. In U.S. Serial No. 76579565 for "Skin Deep Laser MEDSPA," the Respondent submitted three specimens of use: two Sales Receipts dated Feb. 28, 2004 and one Sales Receipt dated Feb. 29, 2004 to the U.S. Patent and Trademark Office on March 4, 2004 for medical and health spa services. This application is currently abandoned (as of July 1, 2005). (See Exhibits 4-7).

8. In U.S. Serial No. 76581391 for "Skin Deep Laser," the Respondent submitted a specimen of use: a Feb. 28, 2004 Sales Receipt to the U.S. Patent and Trademark Office on March 15, 2004 for medical and health spa services. (See Exhibits 8-9).

9. On this information and belief, Petitioner alleges that Respondent did not use the mark "Skin Deep" in commerce as listed on its trademark application (Serial No. 76581387) because Respondent alleges using three separate marks ("Skin Deep," "Skin Deep Laser" and "Skin Deep Laser Medspa") within a same time period (February 2004) for the same medical and health spa services.

10. Count Two: Lack of Use as a Mark Prior to Application or Registration. On information and belief, Petitioner alleges Respondent did not use the mark "Skin Deep" prior to Application or Registration. Looking at all three of the above mentioned Respondent applications, Respondent submitted sales receipts for medical and health spa services within the same time period (Feb. 2004) for the same services (medical and health spa services); Petitioner alleges that Respondent cannot have used all three marks for the same services prior to application or registration. (See Exhibits 1, 3-9).

11. Count Three: Fraud. On information and belief, Petitioner alleges Respondent's registration for "Skin Deep" was obtained fraudulently in that the Respondent failed to use the mark in commerce as applied in the following applications. Said statement was made by an authorized agent of respondent (Jeannette Martello) with the knowledge and belief that said statement was false. (See Exhibits 1, 3-9).

12. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to respondent.

13. Petitioner was damaged by Respondent's alleged false statements and the registration issued. Petitioner has continuously used the mark (Skin Deep Laser Med Spa) since Sept 1, 2003 anywhere and since Jan. 16, 2004 in interstate commerce, and Petitioner's continued and legal use of said mark will be impaired by the continued registration of

said mark of respondent. As a result, Petitioner respectfully requests that the
Commissioner grant this Petition and cancel Registration No. 2932593.

Respectfully Submitted,

Michelle Katz, Esq.
Attorney for Petitioner, ACM, Inc.

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-07-01 16:40:17 ET

Serial Number: 76581387

Registration Number: 2932593

Mark

"Skin Deep"

(words only): "SKIN DEEP"

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-03-15

Filing Date: 2004-03-15

Transformed into a National Application: No

Registration Date: 2005-03-15

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-03-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Martello, Jeannette

Address:

Martello, Jeannette
501 Floral Park Terrace
South Pasadena, CA 91030
United States

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: (626) 403-1747

Petition to Cancel, Reg. 2932593
EXHIBIT 1

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76581387>

7/1/2005

Fax Number: (626) 403-1784

GOODS AND/OR SERVICES

International Class: 044

medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services

First Use Date: 2002-04-20

First Use in Commerce Date: 2004-02-28

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-03-15 - Registered - Principal Register

2005-02-02 - PAPER RECEIVED

2004-12-21 - Published for opposition

2004-12-01 - Notice of publication

2004-10-13 - Law Office Publication Review Completed

2004-10-04 - Assigned To LIE

2004-09-30 - Approved for Pub - Principal Register (Initial exam)

2004-09-30 - Examiners amendment e-mailed

2004-09-30 - Examiners Amendment - Written

2004-09-26 - Case file assigned to examining attorney

2004-03-31 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Petition to Cancel, Reg. 2932593
EXHIBIT 1

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76581387>

7/1/2005

JEANNETTE MARTELLO
501 FLORAL PARK TERRACE
SOUTH PASADENA CA 91030

Phone Number: (626) 403-1747
Fax Number: (626) 403-1784

Petition to Cancel, Reg. 2932593
EXHIBIT 1

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76581387>

7/1/2005

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-07-01 16:41:52 ET

Serial Number: 78569772

Registration Number: (NOT AVAILABLE)

Mark

**SKIN DEEP LASER
MED SPA**

(words only): SKIN DEEP LASER MED SPA

Standard Character claim: Yes

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2005-03-03

Filing Date: 2005-02-17

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: L3D -TMEG Law Office 103 - Docket Clerk

Date In Location: 2005-03-16

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. ACM Enterprises, Inc DBA Skin Deep Laser Med Spa

Address:

ACM Enterprises, Inc DBA Skin Deep Laser Med Spa
1981 New York Drive

Petition to Cancel, Reg. 2932593
EXHIBIT 2

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=78569772>

7/1/2005

Altadena, CA 91001

United States

Legal Entity Type: Corporation

State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 044

International Class 044: Providing cosmetic medical treatments namely laser hair removal, wrinkle correction therapies, removal of birthmarks, spider veins, tattoos, hand and facial skin rejuvenation, acne treatments all supervised by licensed medical staff

First Use Date: 2003-09-01

First Use in Commerce Date: 2004-01-16

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "LASER MED SPA"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-03-01 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Michelle Katz (Attorney of record)

MICHELLE KATZ

4205 KESTER AVE

SHERMAN OAKS, CA 91403-4134

Phone Number: (818) 783-9729

Fax Number: (818) 990-8281

Petition to Cancel, Reg. 2932593
EXHIBIT 2

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=78569772>

7/1/2005

SKIN DEEP

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/18/2004	

Sold To
Christine Burgs

		Check No.	Payment Method	Project
			Cash	
Description	Qty	Rate		Amount
Glycolic peel.		125.00		125.00
Sales payment		-125.00		-125.00

Petition to Cancel, Reg. 2932593
EXHIBIT 3

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-07-01 16:55:07 ET

Serial Number: 76579565

Registration Number: (NOT AVAILABLE)

Mark

SKIN DEEP Laser MEDSPA

(words only): SKIN DEEP LASER MEDSPA

Standard Character claim: No

Current Status: Abandoned-Failure To Respond Or Late Response

Date of Status: 2005-06-30

Filing Date: 2004-03-04

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: M1X -TMO Law Office 110 - Examining Attorney Assigned

Date In Location: 2005-06-30

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Martello, Jeannette Y

Address:

Martello, Jeannette Y
701 Fremont Avenue
South Pasadena, CA 91030
United States

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: (626) 403-1747

Petition to Cancel, Reg. 2932593
EXHIBIT 4

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76579565>

7/1/2005

Fax Number: (626) 403-1784

GOODS AND/OR SERVICES

International Class: 044

medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services

First Use Date: 2004-02-18

First Use in Commerce Date: 2004-02-28

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-06-30 - Abandonment Notice Mailed - Failure To Respond

2005-06-30 - Abandonment - Failure To Respond Or Late Response

2005-02-28 - Amendment From Applicant Entered

2005-02-02 - Unresponsive paper received

2005-02-02 - PAPER RECEIVED

2004-10-04 - Non-final action e-mailed

2004-10-04 - Non-Final Action Written

2004-09-20 - Case file assigned to examining attorney

2004-03-19 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Brandon Tesser (Attorney of record)

Brandon Tesser

TESSER & RUTTENBERG

Petition to Cancel, Reg. 2932593
EXHIBIT 4

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76579565>

7/1/2005

12100 Wilshire Boulevard, Suite 220.
LOS ANGELES CA 90025

Phone Number: 310.207.4022
Fax Number: 310.207.4033

Petition to Cancel, Reg. 2932593
EXHIBIT 4

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76579565>

7/1/2005

Skin Deep Laser MEDSPA

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/29/2004	3

Sold To
Patricia Phillips

Check No.	Payment Method	Project
322	Check	

Description	Qty	Rate	Amount
Laser spider vein treatment of both cheeks		200.00	200.00
Payment		-200.00	-200.00

OSBORNE D PHILLIPS
PATRICIA F PHILLIPS
67 E HOWARD ST
PASADENA, CA 91104

323

DATE 2/29/04

18-06/1220 372

PAY TO THE ORDER OF *Skin Deep Laser Medspa* 200.00

Patricia Phillips DOLLARS

Bank of America

VALUED Customer Since 2002

Patricia Phillips

FOR

⑆122000661⑆0323⑆03721⑆02086⑆

Thank you for your business.

Total

\$0.00

Petition to Cancel, Reg. 2932593
EXHIBIT 5

Skin Deep Laser MEDSPA

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/28/2004	2

Sold To
Annette Palazuelos

Check No.	Payment Method	Project
	VISA	

Description	Qty	Rate	Amount
Laser hair removal of mustache.		100.00	100.00
Payment		-100.00	-100.00
Thank you for your business.		Total	\$0.00

Petition to Cancel, Reg. 2932593
EXHIBIT 6

Skin Deep Laser MEDSPA

701 Fremont Ave.
South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/28/2004	1

Sold To
Linda Palazuelos

Check No.	Payment Method	Project
	ATM	

Description	Qty	Rate	Amount
Laser hair removal of bilateral armpits		150.00	150.00
Laser hair removal of mustache.		100.00	100.00
Payment		-250.00	-250.00
Thank you for your business.		Total	\$0.00

Petition to Cancel, Reg. 2932593
EXHIBIT 7

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-07-01 16:58:46 ET

Serial Number: 76581391

Registration Number: (NOT AVAILABLE)

Mark

"Skin Deep Laser"

(words only): "SKIN DEEP LASER"

Standard Character claim: No

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2004-09-30

Filing Date: 2004-03-15

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:

IIINES REGINA C Employee Location

Current Location: MSR -TMO Law Office 114 - Legal Instruments Examiner

Date In Location: 2005-03-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Martello, Jeannette

Address:

Martello, Jeannette

501 Floral Park Terrace

South Pasadena, CA 91030

United States

Legal Entity Type: Individual

Petition to Cancel, Reg. 2932593
EXHIBIT 8

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76581391&action=Request+Status>

7/1/2005

Country of Citizenship: United States
Phone Number: (626) 403-1747
Fax Number: (626) 403-1784

GOODS AND/OR SERVICES

International Class: 044

medical services; healthspa services, namely cosmetic body care services; cosmetician services; physician services

First Use Date: 2004-02-18

First Use in Commerce Date: 2004-02-28

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-03-01 - Amendment From Applicant Entered

2005-02-02 - Unresponsive paper received

2005-02-02 - PAPER RECEIVED

2004-09-30 - Non-final action e-mailed

2004-09-30 - Non-Final Action Written

2004-09-26 - Case file assigned to examining attorney

2004-03-31 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

BRANDON TESSER, (Attorney of record)

BRANDON TESSER,
TESSER & RUTTENBERG
12100 WILSHIRE BOULEVARD
SUITE 220

Petition to Cancel, Reg. 2932593
EXHIBIT 8

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76581391&action=Request+Status>

7/1/2005

LOS ANGELES, CA 90025
Phone Number: (626) 403-1747
Fax Number: (626) 403-1784

Petition to Cancel, Reg. 2932593
EXHIBIT 8

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=76581391&action=Request+Status>

7/1/2005

Skin Deep Laser
 701 Fremont Ave.
 South Pasadena, CA 91030

Sales Receipt

Date	Sale No.
2/28/2004	1

Sold To
Christine Burgs

		Check No.	Payment Method	Project
			Cash	
Description	Qty	Rate		Amount
Laser hair removal.		150.00		150.00
Payment		-150.00		-150.00
Thank you for your business.		Total		\$0.00

Petition to Cancel, Reg. 2932593
 EXHIBIT 9

EXHIBIT B

Attorneys for Respondent
Jeannette Martello, M.D.

ACM ENTERPRISES, INC.,
Petitioner,
vs.
JEANNETTE MARTELLO, M.D.,
Respondent.

ANSWER TO PETITION FOR CANCELLATION

4. Answering paragraph 4 of the Petition, Martello lacks information or belief

1 sufficient to answer those allegations, and therefore denies all such allegations.

2 5. Answering paragraph 5 of the Petition, Martello admits that, on February 17,
3 2005, ACM filed a U.S. Trademark Application No. 78569772 for "SKIN DEEP LASER MED
4 SPA" for International Class 044. Martello denies the remainder of the allegations in paragraph
5 5.

6 6. Answering paragraph 6 of the Petition, Martello admits that, on March 15, 2004,
7 Martello filed a U.S. Trademark Application Serial No. 76581387 for "SKIN DEEP" for
8 "medical services; healthspa services, namely cosmetic body care services; cosmetician services;
9 physician services." Martello denies the remainder of the allegations in paragraph 6.

10 7. Answering paragraph 7 of the Petition, Martello admits that, on March 4, 2004,
11 Martello filed a U.S. Trademark Application Serial No. 76579565 for "SKIN DEEP LASER
12 MEDSPA" for "medical services; healthspa services, namely cosmetic body care services;
13 cosmetician services; physician services." Martello denies the remainder of the allegations in
14 paragraph 7.

15 8. Answering paragraph 8 of the Petition, Martello admits that, on March 15, 2004,
16 Martello filed a U.S. Trademark Application Serial No. 76581391 for "SKIN DEEP LASER" for
17 "medical services; healthspa services, namely cosmetic body care services; cosmetician services;
18 physician services." Martello denies the remainder of the allegations in paragraph 8.

19 9. Answering paragraph 9 of the Petition, Martello denies all such allegations,
20 except admits that Martello has used the marks "Skin Deep," "Skin Deep Laser," and "Skin Deep
21 Laser Medspa."

22 10. Answering paragraph 10 of the Petition, Martello denies all such allegations.

23 11. Answering paragraph 11 of the Petition, Martello denies all such allegations.

24 12. Answering paragraph 12 of the Petition, Martello denies all such allegations.

25 13. Answering paragraph 13 of the Petition, Martello denies all such allegations.

26 Pleading further, Martello denies that ACM has been damaged by anything Martello did or failed
27 to do or that ACM is entitled to cancellation or any other relief.

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1 **ELEVENTH AFFIRMATIVE DEFENSE**

2 24. Respondent alleges there is no actual conflict between her marks and Petitioner's
3 alleged marks.

4 **TENTH AFFIRMATIVE DEFENSE**

5 25. Respondent alleges there is no evidence that Petition has in fact used its alleged
6 marks in commerce or elsewhere.

7 **PRAYER**

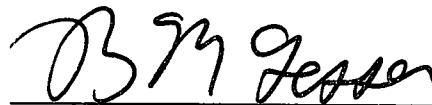
8 WHEREFORE, Respondent Martello prays for judgment as follows:

- 9 1. That Petitioner take nothing by its Petition and that it be denied and dismissed;
10 2. For costs of suit incurred herein, according to proof;
11 3. For reasonable attorneys' fees, if legally proper and allowed by the TTAB; and
12 4. For such other and further relief as the TTAB deems just and proper.

13
14 Dated: August 29, 2005

TESSER & RUTTENBERG

15
16 By:



17 Brandon M. Tesser
18 Attorneys for Respondent
19 Jeannette Martello, M.D.
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1 **PROOF OF SERVICE**

2 STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

3 I am employed in the COUNTY of LOS ANGELES, STATE of CALIFORNIA. I am
4 over the age of 18 and not a party to the within action; my business address is 12100 Wilshire
Boulevard, Suite 220, Los Angeles, California 90025.

5 On August 30, 2005, I served the foregoing document(s) described as **ANSWER TO**
6 **PETITION FOR CANCELLATION** in this action by placing a true copy thereof enclosed in a
sealed envelope addressed as follows:

7 Michelle Katz, Esq.
8 4205 Kester Ave.
9 Sherman Oaks, CA 94103-4134
10 Tel: (818) 783-9729/Fax: (818) 990-8281
11 michelle@mkatzlaw.com
12 *Attorney for Petitioner*

13 [x] **BY MAIL:** I am readily familiar with my firm's practice for the collection and
14 processing of correspondence for mailing with the United States Postal Service.
15 In the ordinary course of business, correspondence would be deposited with the
16 United States Postal Service that same day. I placed true copies of the above-
17 entitled document in envelopes addressed as shown above and sealed and placed
18 them for collection and mailing on the date stated above, following ordinary
19 business practices.

20 [] **BY PERSONAL SERVICE:** I caused such envelope to be delivered by hand to
21 the offices of the addressee(s) as marked with an ***.

22 [] **BY FEDERAL EXPRESS:** I caused said envelope(s) to be sent by Federal
23 Express to the addressee(s) on the attached service list.

24 [] **BY TELECOPIER:** In addition to the above service by mail, hand delivery, or
25 Federal Express, I caused said document(s) to be transmitted by telecopier on
26 June 24, 2005 at approximately 6:30 p.m. to the addressee(s) above.

27 [x] (Federal) I declare that I am employed in the office of a member of the bar of this
28 court at whose direction the service was made.

Executed on August 30, 2005, at Los Angeles, California.

22 
23 Wendy Southart
24

EXHIBIT C

LAW OFFICE OF DAVID HONG

David Hong, Esq.
P.O. Box 2111
Santa Clarita, CA 91386-2111

Telephone: (866) 824-8680
Facsimile: (866) 824-8680
david.hong@dhpatentlaw.com

Patent, Trademark, Copyright, Trade Secret &
Related Causes

January 13, 2006

Mr. Brandon Tesser, Esq.
TESSER & RUTTENBERG
12100 Wilshire Blvd., Suite 220
Los Angeles, CA 90025

VIA MAIL & E-Mail: btesser@tesser-ruttenberg.com

Re: Client: ACM Enterprises, Inc./Skin Deep Laser MedSpa
CANCELLATION NO. 92044697
ACM Enterprises, Inc. vs. Jeannette Martello, M.D.
Petition to Cancel Registration No. 2932593 (Pet. Filed July 1, 2005)
Serial No. 76581387 (filed March 15, 2004) - Mark: "'SKIN DEEP'"
Attorney File No. 2005-02-0107

Dear Brandon:

Jan. 18, 2005 Deposition of Dr. Martello

I wanted to confirm with you the scheduled deposition of Dr. Martello on Wed., Jan. 18, 2006, at 9:30 a.m. at Ben Hyatt Certified Deposition, 18226 Ventura Blvd., Suite 103, Tarzana, CA 91356. Please confirm with your client and advise if any rescheduling is necessary.

Document Production in Response to the 10-31-2005 Petitioner's Document Request

In response to the Petitioner's 10-31-2005 document request, you provided documents for my pick up on the following dates:

1. First production: 12-28-2005

Comprising: several audiotapes, a videotape, a cd-rom, several "SKIN DEEP" magazines, and various papers and photographs.

2. Second production: 01-06-2006

Comprising: "MAR 0001 to MAR 0401."

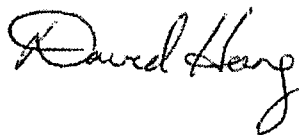
Mr. Brandon Tesser, Esq.
TESSER & RUTTENBERG
Re: Client: ACM Enterprises, Inc./Skin Deep Laser Med Spa
Petition to Cancel Registration No. 2932593
Mark: "SKIN DEEP"
Attorney File No. 2005-02-0107
January 13, 2006
Page 2

I wanted to make sure that I received your entire document production because the 01-06-2006 production (documents "MAR 0001 to MAR 0401") did not include any of the documents from the 12-28-2005 production. Also, document MAR 0028 was marked "Martello v. Oxygen - client docs."

Based on our brief conversation on 12-28-2005, I understood that in the second production, you would only copy the first page of the "SKIN DEEP" magazines, instead of copying the entire magazines but would be providing all of the documents in a BATES stamped format. Please advise.

Very truly yours,

David Hong, Esq.

A handwritten signature in cursive script that reads "David Hong".

Digitally signed by DAVID HONG
DN: CN = DAVID HONG, C = US,
O = Law Office of David Hong
Reason: I am the author of this
document
Location: Santa Clarita, CA
Date: 2006.01.13 11:27:43 -08'00'

EXHIBIT D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ACM ENTERPRISES, INC.,)

Petitioner,)

vs.)

JEANETTE MARTELLO, M.D.,)

Respondent.)

ORIGINAL

) CANCELLATION NO.

) 92044697

Deposition of JEANNETTE MARTELLO, M.D.,

at 18226 Ventura Boulevard,

Tarzana, California, commencing at

10:13 a.m., Wednesday, January 18, 2006,

before Colleen Ellfeldt, CSR No. 10766.



JEANNETTE MARTELLO, M.D.

1 APPEARANCES OF COUNSEL:

2
3 FOR THE PETITIONER:

4
5 THE LAW OFFICES OF DAVID HONG
6 BY: DAVID HONG, ESQ.
7 P.O. BOX 2111
8 Santa Clarita, California 91386
9 (866) 824-8680

10
11 FOR RESPONDENT JEANNETTE MARTELLO, M.D.:

12
13 TESSER & RUTTENBERG
14 BY: BRANDON M. TESSER, ESQ.
15 12100 Wilshire Boulevard
16 Suite 220
17 Los Angeles, California 90025
18 (310) 207-4022

19
20
21
22 ALSO PRESENT:

23
24 COLIN HURREN
25

JEANNETTE MARTELLO, M.D.

1 A. I want to say it was at the beginning.

2 Q. All right. When -- thinking back to when
3 you first met her, did she tell you about what she
4 does for a living?

5 A. We were introduced for that reason
6 actually.

7 Q. And then when did you first find out
8 about Skin Deep Skin Care?

9 A. The first introduction.

10 Q. All right. All right. But before that
11 time did you ever know about the Skin Deep Skin Care
12 that Ms. Herrick ran?

13 A. I may have come across an ad or two, but
14 I never put two and two together.

15 Q. In the deposition -- I mean in the
16 discovery responses that you provided, I believe there
17 was a common law mark search for Skin Deep. It was a
18 thick document, but to the best of your recollection
19 do you remember ever coming up with the term Skin Deep
20 Skin Care?

21 A. Me coming up with the term?

22 Q. No. Do you recollect -- to the best of
23 your recollection -- I know it might be difficult -- I
24 am just going to ask do you ever remember seeing the
25 mark "Skin Deep Skin Care" in the common law

1 **CERTIFICATE OF SERVICE**

2 I hereby certify as follows:

3 I am employed in the COUNTY of LOS ANGELES, STATE of CALIFORNIA. I am over
4 the age of 18 and not a party to the within action; my business address is 12100 Wilshire Boulevard,
Suite 220, Los Angeles, California 90025.

5 On September 7, 2007, I served the foregoing document(s) described as **DECLARATION**
6 **OF BRANDON M. TESSER AND EXHIBITS IN SUPPORT OF MARTELLO'S**
7 **OPPOSITION TO PETITIONER'S MOTION FOR LEAVE TO AMEND AND FOR**
8 **SUMMARY JUDGMENT** in this action as follows:

- 9 1) Via electronic mail to: David Hong [david_hong@sbcglobal.net], Counsel for
10 Petitioner herein, and:
11 2) By mail, by placing a true copy thereof enclosed in a sealed envelope addressed as
12 follows:

13 David Hong, Esq.
14 Law Office of David Hong
15 P.O. Box 2111
16 Santa Clarita, California 91386-2111
17 Tel/Fax: (866) 824-8680
18 *Attorney for Petitioner ACM Enterprises, Inc.*

19 [x] **BY MAIL:** I am readily familiar with my firm's practice for the collection and
20 processing of correspondence for mailing with the United States Postal Service. In
21 the ordinary course of business, correspondence would be deposited with the United
22 States Postal Service that same day. I placed true copies of the above-entitled
23 document in envelopes addressed as shown above and sealed and placed them for
24 collection and mailing on the date stated above, following ordinary business
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to the addressee(s) on the attached service list.

[] **BY TELECOPIER:** In addition to the above service by mail, hand delivery, or
Federal Express, I caused said document(s) to be transmitted by telecopier on
September 7, 2007 at approximately _____ a.m./p.m. to the addressee(s) above.

[x] (Federal) I declare that I am employed in the office of a member of the bar of this
court at whose direction the service was made.

Executed on September 7, 2007, at Los Angeles, California.

26 
27 Vivian Cha